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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,490	10/03/2003	Derek Lydiate	11089.0003.NPUS01	8191
27194 7590 07/24/2008 HOWREY LLP-CA C/O IP DOCKETING DEPARTMENT 2941 FAIRVIEW PARK DRIVE, SUITE 200 FALLS CHURCH, VA 22042-2924				
EXAMINER ZHENG, LI				
ART UNIT		PAPER NUMBER		
1638				
MAIL DATE		DELIVERY MODE		
07/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/678,490

**Applicant(s)**

LYDIATE ET AL.

**Examiner**

LI ZHENG

**Art Unit**

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10 and 14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8, 10 and 14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 20, 2008 has been entered.

As a result, claims 1-8, 10 and 14 are pending and examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejections and objection not set forth in this action are withdrawn.

***Claim Rejections - 35 USC § 112***

***New Matter***

4. Claims 1-8, 10 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 have been amended to recite "a tag protein that is benign to the plant or portion thereof when expressed" and "the coding region of interest which does not include an antibiotic resistance or herbicide resistance selection". Applicants point to support for the phrase in the instant specification on page 3, lines 12-19 and the paragraph bridging pages 71-72 (response, the paragraph bridging pages 5-6). However, the specification clearly defines "tag protein" as any protein that is capable of being identified in a plant. The specification does not have support for the subgenus of "a tag protein that is benign to the plant or portion thereof when expressed". Further, there is also no support for "the coding region of interest which does not include an antibiotic resistance or herbicide resistance selection". Therefore the amendments are considered as NEW MATTER.

***Claim Rejections - 35 USC § 103***

5. Claims 1-8, 10 and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fabijanski et al. in view of Mason et al. and Chou et al., for the

reasons of record stated in the Office action mailed February 20, 2008. Applicants traverse in the paper filed May 20, 2008. Applicants' arguments have been fully considered but were not found persuasive.

Applicants argue that Fabijanski et al. teach away from the use of conditional lethal genes (response, the paragraph bridging pages 10-11) and that there is no disclosure that this conditional lethal gene is in operative association with an operator sequence (response, page 11, 2nd paragraph).

The Office contends that Fabijanski et al. do not teaches away from the use of conditional lethal genes. On the contrary, in the working example, Fabijanski et al. teach that the repressible promoter containing three copies of tet operator sequence is operably linked to Oncogene 1, which is considered as a conditional lethal gene (Example 2, Col. 30 lines 33-58 and Col. 32, lines 34-45).

Applicants further argue that Fabijanski et al. do not teach the selection step defined in amended claims 1 and 14, and modification of the method of combined teachings do not rectify this (response, page 11, 4<sup>th</sup> paragraph).

The Office contends that selection step is clearly disclosed in the last step of claims 1 and 8. In addition, Fabijanski et al. teach that when expressed, the two oncogenes in this vector lead to the formation of excess IAA, killing plant cells in which the lethal gene activity is expressed.

### ***Double Patenting***

Art Unit: 1638

6. Claims 1-8, 10 and 14 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-24 of copending Application No. 10/719,996 in view Mason et al.

Applicants wish to postpone the response to this rejection until the claims are otherwise allowable (page 19, 2<sup>nd</sup> paragraph). Therefore the rejection is maintained.

7. Claims 1-8, 10 and 14 remain provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18, 21 and 24 of copending Application No. 10/995,951 in view Mason et al.

Applicants wish to postpone the response to this rejection until the claims are otherwise allowable (page 19, 4<sup>th</sup> paragraph). Therefore the rejection is maintained.

### ***Summary***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Zheng whose telephone number is 571-272-8031.

Art Unit: 1638

The examiner can normally be reached on Monday through Friday 9:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Li Zheng/

Examiner, Art Unit 1638